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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,012	03/16/2005	Hisanao Takahashi	1419.1109	9175

21171 7590 11/01/2006

STAAS & HALSEY LLP  
SUITE 700  
1201 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER

LOWEN, ALYSSA

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/528,012

Applicant(s)

TAKAHASHI ET AL.

Examiner

Alyssa M. Lowen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 5 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Koguchi (4913676). Koguchi discloses a robot bird toy that changes its form by flapping its wings (Fig. 3) or turning its neck (Fig. 2). Different movements such as a beak opening and closing are performed before, after and during the form change (Fig. 2). A first toy component (4) in the form of a lower jaw is arranged on a link (91) facing a frame in a trunk portion of the toy via a lever (102) as part of a four-section link (Fig. 2). A second toy component (4) in the form of an upper jaw is arranged on one of a pair of swinging links (102) so that it faces the other component and extends away from or on an opposite side of the frame since the link includes a rod (99) whose tip is rotatably and swingably engaging with a rotating disk (97) at an eccentric position (Fig. 2). The components are rotated and perform an opening and closing movement with each other due to rotation of the rotating disk (Fig. 2).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamakawa (5902169). Yamakawa discloses a robot toy that can change its form when a control unit in the form of a movable arm is moved allowing a clutch mechanism to become engaged and transmit power from a motor to another part of the toy causing it to rotate (column 2 lines 31-56). A switch activated by movement of the control unit allows a sound produced by the toy before and after the form change to be altered (column 9 lines 13-32). The reference discloses the basic inventive concept, substantially as claimed, with the exception of the control unit being a movable leg portion and the form change being a change from a standing posture to a bent posture. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the leg be the control unit thereby causing the device to switch from a standing form to a bent form because Applicant has not disclosed that the leg control unit and the standing or bent forms provide an advantage, are used for a particular purpose, or solve a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the arms being the control unit and the forms being an exposed face form and a hidden face form since an entertaining and amusing device is still created.

5. Claims 3-4 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamakawa and Koguchi. Yamakawa discloses the basic inventive concept, substantially as claimed, with the exception of a four-section link. Koguchi discloses a

robot bird toy that changes its form by flapping its wings (Fig. 3) or turning its neck (Fig. 2). Different movements such as a beak opening and closing are performed before, after and during the form change (Fig. 2). A first toy component (4) in the form of a lower jaw is arranged on a link (91) facing a frame in a trunk portion of the toy via a lever (102) as part of a four-section link (Fig. 2). A second toy component (4) in the form of an upper jaw is arranged on one of a pair of swinging links (102) so that it faces the other component and extends away from or on an opposite side of the frame since the link includes a rod (99) whose tip is rotatably and swingably engaging with a rotating disk (97) at an eccentric position (Fig. 2). The components are rotated and perform an opening and closing movement with each other due to rotation of the rotating disk (Fig. 2). It would have been obvious to one of ordinary skill in the art to modify the rotating part of Yawakawa to the four section link as disclosed by Koguchi in order to create a device having an actuatable mouth portion to entertain or amuse a child. -

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tepper (3755960), Wolfram (5478269), Hurt (5727982) and Arriola (6152799) disclose toys that utilize a leg portion to initiate a form change in a toy figure.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alyssa M. Lowen whose telephone number is 571-272-2684. The examiner can normally be reached on M-F (8-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AML

  
EUGENE KIM  
SUPERVISORY PATENT EXAMINER